

REMARKS

103 Rejection

Claims 1, 4-6, 8-10, 13 and 14 are pending in the instant application. Claims 1, 4-6, 8-10, 13 and 14 stand rejected under 35 U.S.C. §103 as being unpatentable in view of United States Patent No. 4,994,013 to Suthanthiran et al. (“Suthanthiran”). This rejection is respectfully traversed.

The present invention is directed to a radioactive source for brachytherapy which includes a radioactive isotope of iodine or iodide ions adsorbed onto a non-radiation attenuating substrate.

Suthanthiran discloses a metallic X-ray detectable marker rod coated with a radioactive-absorbing material in a binder into which a radioactive material is absorbed.

On the bottom of page 2 of the Office Action dated February 8, 2006 (“Office Action”), the Examiner states that “Applicant’s arguments are non-persuasive because the cited prior art discloses that absorption of the radioactive material may occur.” Applicants agree with the Examiner that the cited prior art discloses that absorption of the radioactive material may occur. Applicants again respectfully submit that Suthanthiran does not disclose, teach, or suggest that the radioactive material is adsorbed onto a substrate as is claimed in the present invention.

Additionally, on page 3 of the Office Action, the Examiner states “that the amended claims do not exclude material being absorbed onto the surface”. Applicants respectfully submit that one skilled in the art would recognize that the term adsorption has a completely different meaning than the term absorption. Moreover, on page 3 of the Office Action, the Examiner clearly recognizes the difference between the term adsorption and absorption by separately defining each term. The present inventive claims clearly set forth that the radioactive material is adsorbed on the surface of a substrate. The present claims clearly do not disclose that the radioactive material is absorbed on the surface of the substrate. Accordingly, it is well settled in case law that prior patents are references only for what they clearly disclose or suggest. Additionally, it is not proper use of a patent as a reference to modify its structure to one which prior art references do not suggest. *In re Randol and Redford*, 425 F.2d 1268, 165 U.S.P.Q. 586, 588 (C.C.P.A. 1970). A reference must be considered not just for what it expressly teaches, but also for what it fairly suggests to one who is unaware of the claimed invention. *In re Baird*, 16 F.3d 380, (Fed. Cir. 1994).

Additionally, Suthanthiran only discloses that the radioactive material is absorbed by radioactive-absorbing material used to coat the substrate/rod. Suthanthiran fails to disclose, teach, or suggest that the radioactive material is adsorbed onto a substrate as is claimed by the present invention. Applicants further submit that as Suthanthiran requires its marker rod be coated with a radioactive-absorbing material, to suggest that the radioactive-absorbing material was not necessary would require impermissibly ignoring the specific teachings of the reference. Applicants respectfully submit that Suthanthiran

provides no motivation for adsorbing a radioisotope to the surface of a substrate itself. Suthanthiran fails to disclose, teach, or suggest a radioactive material adsorbed on the surface of a non-radiation attenuating substrate.

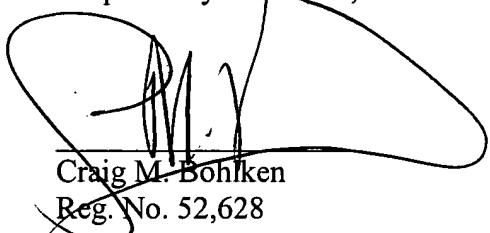
Furthermore, Suthanthiran discloses that a pellet is encapsulated by a titanium container or another material other than titanium, column 5, lines 13-26. Suthanthiran does not teach, suggest, or is motivated to encapsulate the pellet with a biocompatible container as claimed in the present invention. To equate a container made with material other than titanium with a biocompatible container is a far-reaching comparison. Additionally, to support a case for obviousness, the proper test is whether the reference, taken as a whole, would suggest the invention to one of ordinary skill in the art. *Milliken Research Corp. v. Dan River, Inc.*, 222 U.S.P.Q 571 (Fed. Cir. 1984). Accordingly, it is respectfully submitted that the Examiner has been unable to show that Suthanthiran, taken as a whole, would suggest the present invention to one of ordinary skill in the art.

Therefore, Applicants respectfully submit that the present invention is patentably distinct from Suthanthiran. Reconsideration and withdrawal of the rejection are respectfully requested.

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In view of the amendments and remarks hereinabove, Applicants respectfully submit that the instant invention, including claims 1, 4-6, 8-10, 13 and 14, are patentably distinct over the prior art. Favorable action thereon is respectfully requested.

Respectfully submitted,


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